REMARKS/ARGUMENTS

The Rejection of Claims 1-5, 14-15, 17, 21 and 23-30 under 35 U.S.C. §102

The Examiner rejected the above-identified claims as being anticipated by U.S. Patent No. 5,513,853 (Crompton et al.). More specifically, the Examiner indicated that Crompton et al. disclosed an amusement game for securing at least one prize/object on a platform, "in which the examiner interprets to be the hopper (7) to be equivalent to a platform, and a device (15 and 10) for determining the characteristic of the at least one prize/object as recited in claims 1 and 26; the device is a scale (15) and the characteristic is weight (15)...the examiner interprets the number of balls collected within a hopper within the given time period to be equivalent to the predetermined weight range as recited in claim 3..." The Examiner also took liberty with regard to certain other "interpretations" to conclude that the present invention comprised structures and functions that were "equivalent" to those disclosed by Crompton et al. such that the above-identified claims were anticipated. Applicants traverse the rejection inasmuch as the rejection may apply to the claims as amended.

Under U.S. patent law, "a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in... the claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913 (Fed Cir. 1989) (emphasis added). "The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of

terminology is not required." *In re Bond*, 15 USPQ2d 1566 (Fed Cir. 1990) (emphasis added). Additionally, "extrinsic evidence may be used to explain but not expand the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter." *In re Baxter Travenol Labs.*, 21 USPQ2d 1281 (Fed. Cir 1991) (emphasis added). "To serve as anticipation when a reference is silent about the asserted inherent characteristic, such gap may be filled with recourse to extrinsic evidence." *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ2d 1746 (Fed Cir 1991) (emphasis added).

In the present case, the Crompton et al. reference cited by the Examiner does not disclose each and every element of Claims 1, 26 and 29 as arranged in order to anticipate the present invention. The Crompton et al. reference does not disclose means or methods for performing an operation to measure or determine mass or weight of prizes/objects and Crompton et al. do not even disclose a device for measuring mass or weight; e.g., a scale for measuring mass or weight of an object. What Crompton et al. do disclose is a device for counting the number of balls collected by a game player. Indeed, column 1, lines 23-26 of the Crompton et al. reference specifically discloses, "the prize is then dispensed according to the number of balls collected at the collection station in a fixed time and the number of balls collected is measured by the sensor means." Column 1, lines 64 and 65 of the Crompton et al. reference describes a collector hopper "which counts how many balls have been collected." Column 3, lines 1-5 of the Crompton et al. reference describes "sensor 26 in the hopper 7 measures the number of balls collected therein, and simulates this as tonnes on the tonnage dial." Column 3, lines 12-17 describe dispensing a prize "dependent upon the number of balls collected." Finally, as illustrated in Figure 2A of the

Crompton et al reference, sensor 26 is positioned proximate the conveyor means and hopper for counting the number of balls that pass the sensor as they fall into the hopper. In sum, the Crompton et al. invention does not comprise means for actually determining the mass or weight of the prizes/objects. Additionally, it should be appreciated that while Crompton et al. disclose displaying the number of balls collected as "tonnes" by means of dial 15, such figure is simulated tonnage, which is based on the ball count. Finally, the Examiner refers to dial 15 as a "scale", dial 15, however, of the Crompton et al reference is for display purposes only and is not adapted for measuring mass or weight of prizes/objects and/or comprising a representation of mass or weight. Consequently, because Crompton et al do not disclose means or methods for measuring mass or weight, the Crompton et al reference does not disclose the each and every element of the invention as claimed to uphold a rejection based on anticipation.

Reversal of the rejection on these grounds is, thus, courteously requested.

Additionally, the Examiner "interpreted" of various structures described by Crompton et al. as being "equivalent" to subject matter disclosed in the present application and claims; such "interpretation" by the Examiner is inappropriate and impermissible under law. First, the Examiner provides no extrinsic evidence to illustrate that one having ordinary skill in the art would "interpret" certain structures identified by Crompton et al.'s as being "equivalent" to those of the Applicants. Indeed, the Examiner baldy states, "the examiner interprets a hopper to be equivalent to a platform", "the examiner interprets the number of balls to be equivalent to the predetermined weight range", "the examiner interprets the number of balls within the hopper measured by the dial...", and the Examiner indicated that Crompton et al.'s dial 15, for

simulating "tonnage", was equivalent to Applicant's scale for measuring mass or weight. The Examiner cited no objective, extrinsic evidence or authority to support such assertions. Second, the Examiner's "interpretations" of "equivalence" are erroneous and impermissibly expand and/or alter the plain meanings of the terms/phrases utilized by Crompton et al. For example, the Examiner asserts that the number of balls counted is equivalent to weight. However, "number" is very different from "mass" or "weight"; "number" is a unitless means of measurement whereas mass and weight are definable by units of measure (grams/lbs). Likewise, the Examiner asserts that "simulated tonnage", based on number of balls collected, is equivalent to actual weight. However, "simulated" tonnage is just that, simulated, and has absolutely nothing to do with an actual measurement of mass or weight. Furthermore, it should be appreciated that, according to Dictionary.com, "hopper" is defined as "a usually funnel-shaped container in which materials, such as grain or coal, are stored in readiness for dispensation" and "platform" is defined as "any flat or horizontal surface; especially, one that is raised above some particular level." Thus, "hopper" is not equivalent to platform. Also, "dial 15" for simulating tonnage is wholly different from a scale or device for measuring the mass or weight of a prize/object. "Dial 15" is used for displaying a representation of a number of balls collected whereas a "scale" is used for measuring mass or weight of prizes/objects. Thus, it is seen that the definitions of "hopper", "platform", "dial" and "scale" are very different from one another such that they cannot be arbitrarily deemed "equivalent" by the Examiner.

Thus, it is seen that the Examiner's interpretations of equivalence are completely subjective, wholly unsupported by objective evidence, and improper under law because they

expand the meaning of the terms and phrases as used by Crompton et al. As previously noted, "extrinsic evidence may be used to explain but not expand the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter." *In re Baxter Travenol Labs.*, 21 USPQ2d 1281 (Fed. Cir 1991) (emphasis added).

Reversal of the rejection on these grounds is, thus, courteously requested.

In sum, contrary to the Examiner's assertions, the Crompton et al. reference does not disclose that the mass or weight of a prize/object is measured as required by Claims 1, 26 and 29, and those claims depending therefrom. The Crompton et al. reference discloses that a sensor counts the number of balls collected and then simulates the number of balls as "tonnes" on a tonnage dial displayed to the user. Thus, the Crompton et al. invention does not actually perform a measurement of the mass or weight of the prizes/objects collected by a game player. Additionally, the Examiner subjective interpretation of equivalent structures is improper and impermissible under law. For the reasons set forth above, Applicants respectively submit that Crompton et al. do not anticipate the present invention as claimed.

Reversal of the rejection is requested

The Rejection of Claims 6-13, 16, 18-20 and 22 under 35 U.S.C. §103

The Examiner rejected the above-identified claims as being obvious in view of the teachings of the previously cited Crompton et al. reference and U.S. Patent No. 6,234,487 (Shoemaker, Jr.), which teaches a crane game claw assembly. Applicants respectfully traverse the rejection inasmuch as the rejection applies to the claims as amended.

"To establish a *prima facia* case of obviousness, three basic criteria must be met: 1.) there must be some suggestion or motivation, either in the references or in that knowledge generally available to one having ordinary skill in the art, to modify the reference or to combine reference teachings, 2.) there must be a reasonable expectation of success, and 3.) the prior art references must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success invention must both be found in the prior art and not based on applicant's disclosure." MPEP §2142; citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

As previously noted with regard to the rejections under 35 USC §102, the Crompton et al. reference does not disclose, teach or suggest all the limitations of the invention as claimed to uphold a rejection under 35 USC §103. Indeed, Crompton et al. do not disclose, teach or suggest a crane amusement game operatively arranged for measuring and/or determining the mass or weight of one or more prizes/objects and does not disclose, teach, or suggest a crane amusement game operatively arranged to award a prize/object when the mass or weight of a prize/object is within a predetermined range. Similarly, U.S. Patent 6,234,487 (Shoemaker Jr.) does not disclose, teach or suggest a crane amusement game operatively arranged and/or comprising means for measuring and/or determining mass or weight pr prizes/objects.

In simplest terms, the inventions disclosed by Crompton et al. and Shoemaker Jr. are not configured for measuring mass or weight of an object. Hence, because the prior art references cited by the Examiner do not disclose, teach or suggest all of the limitations of the present

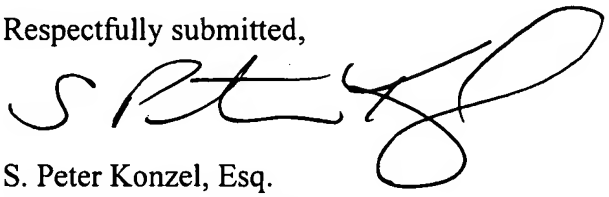
invention as claimed, Applicant respectfully submits that the present invention is non-obvious in view of Crompton et al. and Shoemaker Jr.

Reversal of the rejection is requested.

Conclusion

Applicant respectfully submits that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,



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